ARGUMENTS/REMARKS

Applicants would like to thank the Examiner for the careful consideration given the present application, and for the personal interview conducted on April 23, 2004 with the Examiner and his supervisor. The application has been carefully reviewed in light of the Office action and interview, and amended in response thereto.

Claims 1-16 remain in this application. Claim 17 has been added without adding any new matter.

Claims 1-6 were rejected under 35 U.S.C. §103(a) as being unpatentable over Riek (U.S. 5,987,179) in view of Gabriel (U.S. 5,973,755). For the following reasons, the rejection is respectfully traversed.

Claim 1, as amended, recites:

An information providing apparatus for acquiring contents data representing a high quality still image from a *service providing apparatus* capable of storing the contents data and of transmitting the contents data in response to a request from a *remote user terminal*, and for providing the contents data in a direct format or in a converted format to the remote user terminal

Neither reference suggests any such "service providing apparatus" which provides content data to an "information providing apparatus" in response to a request by a "remote user terminal". This was discussed in detail at the personal interview with the Examiner and his supervisor. Instead, Riek recites a method and apparatus for encoding high-fidelity still images into MPEG bitstreams. Thus, Riek merely discusses an MPEG recorder, which converts a camera image into a compressed image for storage. There is no "service providing apparatus" and "information providing apparatus" as suggested by the reference. Riek does not suggest any services being provided. Gabriel does not overcome the Riek shortcomings. Thus, claim 1 is patentable over the references.

Claim 1 further recites:

control means for determining an area of the still picture data coded into the compressed moving picture data in response to *a user selection of a portion of the still display picture* made from the *remote user terminal*, and for notifying the selected area to the moving picture coding means

(lines 22-28, emphasis added). As discussed at the personal interview, neither of the cited

references suggest the cited limitations. The invention as claimed provides that user manipulation occurs at the remote terminal, but processing of the data occurs at the information providing apparatus. Thus, the processing has been offloaded from the mobile terminal (where the picture is displayed), to the communication provider.

In the Office action, the Examiner cites Gabriel as teaching a "zooming" ability, and argues that "the motion vector's value is zero" and that a "translational movement may be performed, and that all of the motion vectors point in the same direction" (col. 7, lines 26-34). The Examiner concludes that "thus Gabriel does teach 'control means for determining an area of the still picture data coded into the compressed moving picture data in response to a manipulation made from the user terminal and for notifying the determined area to the moving picture coding means'".

However, the Examiner's conclusion is not supported by the cited passages. The cited portion discusses how an encoded zoom operation would have no motion vector (see col. 7, lines 15-21). The discussed zoom is *already embedded in the video image*, it is *not* the result of a *manipulation from a user terminal*. Instead, the Gabriel disclosure is discussing zooms in the video itself, perhaps an image zoomed by the camera, for example. But there is no suggestion that Gabriel supports a manipulation from a user terminal.

Further, Gabriel does not suggest that there is any notification to a moving picture encoding means of a "determined area". This is unnecesary because the Gabriel encoding means does not perform any zoom function. Thus, for either or both reasons, claim 1 is patentable over the combination of references because Gabriel does not teach the cited limitations.

Still further, the Examiner has not provided the proper motivation for combining the references. The burden is on the Examiner to make a prima facie case of obviousness (MPEP §2142). To support a prima facie case of obviousness, the Examiner must show that there is some *suggestion* or *motivation* to modify the reference (MPEP §2143.01). The mere fact that references *can* be combined or modified, alone, is not sufficient to establish prima facie obviousness (*Id.*). The prior art must also suggest the *desirability* of the combination (*Id.*). The fact that the claimed invention is within the *capabilities* of one of ordinary skill in the art is not sufficient, by itself, to establish prima facie obviousness (*Id.*). Merely stating that the combination is "obvious" is not motivation.

The Examiner argues that the motivation is provided because both references discuss MPEG encoding, and because zooming is well known, and thus it would be desirable to combine the references. However, this argument is not sufficient to support a prima facie case of obviousness. It is not enough to provide a benefit. The Examiner must show why a reader of Riek would be motivated to provide the functionality of Gabriel in the Riek device. Instead, the Examiner attempts to rely on the benefits of the invention itself, thus providing hind-sight analysis. Further, it is not enough to merely show so me benefit. The Examiner must show a convincing reason that the reader would add that benefit to the base reference. This has not been done.

Accordingly, because no proper motivation has been provided, the rejection for obviousness is improper. Further, as discussed at the interview, because the references do not suggest offloading the image processing as claimed by claim 1, they cannot render the claim obvious.

Thus, claim 1 is patentable over the references. Claims 2-3, which depend on claim 1, are patentable for the same reasons (as well as for the limitations contained therein).

Claim 4 contains a similar limitations, as discussed for claim 1. Claim 4 has an information providing apparatus, and discusses user selection at lines 20-23. Thus, claim 4 is patentable over the references for the same reasons discussed for claim 1. Claims 5-6, which depend on claim 4, are patentable for the same reasons (as well as for the limitations contained therein).

Claims 7-16 were rejected under 35 U.S.C. §103(a) as being unpatentable over Riek (U.S. 5,987,179) in view of Gabriel (U.S. 5,973,755), Tracton (U.S. 6,470,378), and Guedalia (U.S. 6,536,043). For the following reasons, the rejection is respectfully traversed.

Claims 7 & 13, as amended and like the claims discuss above, discuss an information providing system for acquiring content data from a service providing system, and for providing a communication service to a remotely located mobile terminal. The claims further recite "transmitting means for transmitting the compressed moving picture data to the mobile terminal" (lines 9-10) where "the mobile terminal displays a still display image representing the high-quality still image from the compressed moving picture data, such that image processing of the content data is primarily conducted by the information providing system to

thereby reduce a processing load and/or a memory requirement on the mobile terminal". As discussed at the personal interview, these features are not suggested by the references. Neither of the references suggest these limitations.

Note that claim 13 recites an invention that makes it possible for a mobile terminal that is capable of displaying *moving pictures* (i.e., video) from compressed moving picture data (such as MPEG for example—see specification), to also display high-quality *still* pictures of many different formats. The processing and conversion are primarily done *outside* of the mobile device (i.e., at the information providing apparatus), but it allows a mobile terminal capable of displaying video in a given format to *also* display still pictures originating from data that is not compatible with the mobile device. In this manner, the mobile device doesn't require the processing and/or memory requirements that it might otherwise.

The Examiner cites Tracton as teaching that mobile terminal receives an MPEG stream from a transmitter. However, the cited passages do not suggest displaying a *still image* on a mobile terminal that can display *moving picture data*. The reference merely states that "one can easily support other architectures, such as text-only pagers or cellular-phone based browsers...." The reference does not define such support, and clearly does not suggest that still images are displayed, nor does it suggest a mobile terminal capable of displaying moving images (e.g., the reference to "text-only clearly teaches *away* from any image display). Guedalia fails to overcome the cited shortcomings. Hence, the references, even if combined, fail to teach all of the elements of claims 7 & 13.

Accordingly, claims 7 & 13 are patentable over the references. The remaining previously presented claims depend, directly or indirectly, upon one of claims 7 & 13, and thus are patentable over the references for at least the same reasons.

Further, new claim 17 recites limitations similar to those discussed above, and thus claim 17 is patentable for those reasons as well.

Finally, the Examiner has again failed to provide legally sufficient motivation for combining the references, and thus the rejection is improper.

In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it

is determined that the application is not in a condition for allowance, the examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 32626.

Respectfully submitted,

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